IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	Confirmation No. 7212
Mark Thompson, et al.	Examiner: JACOS, LASHONDA T.
Application No.: 10/032,796	Technology Center/Art Unit: 2157
Filed: December 26, 2001	APPELLANTS' BRIEF UNDER 37 CFR §41.37
For: FORMS AUDITING SYSTEMS AND METHODS	

Mail Stop Appeal Brief
Commissioner for Patents
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Sir:

            Further to the Notice of Appeal mailed on February 14, 2007 for the above-referenced application, Appellants submit this Brief on Appeal.

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1. REAL PARTY IN INTEREST

At the time of the filing of this appeal brief, First Data Corporation is the real party in interest for this appeal.

2. RELATED APPEALS AND INTERFERENCES

No other appeals or interferences are known which will directly affect, are directly affected by, or have a bearing on the board decision of the pending appeal.

3. STATUS OF CLAIMS

Claims 1-15 were originally filed in the application on December 26, 2001. Claim 16 was added by Amendment dated June 6, 2005. Claims 1-16 stand rejected by the Examiner.

Claims 1-16 are believed improperly rejected and are the subject of this appeal. A copy of the claims as rejected is attached as an Appendix.

4. STATUS OF AMENDMENTS

All Amendments have been entered. No amendments have been filed subsequent to the Final Office Action mailed November 15, 2006 ("Final Office Action").

5. SUMMARY OF CLAIMED SUBJECT MATTER

In the following summary, Appellants have provided references to sections of the specification and drawings supporting the subject matter defined in the claims as required by 37 C.F.R. §41.37. The specification and drawings also include additional support for other exemplary embodiments encompassed by the claimed subject matter. Thus, these references are intended to be illustrative in nature only. Claims 1, 11, and 16 are the independent claims.

Claim 1 recites a method for auditing forms. The method includes issuing a request to provide a form identifier that is associated with a form. Original Application, p. 4, ll. 18-24; p. 5, ll. 9-11. The identifier is then received at a host computer. Id., p. 5, ll. 10-12. The

host computer verifies whether the identifier is a valid identifier for the form being used. Id., p. 4, ll. 22-23; p. 5, ll. 10-12.

Claim 11 recites a forms auditing system that includes a host computer 12 associated with a database 14. Id., p. 3, ll. 21-25; Fig. 1, ref. nums. 12, 14. The database has a record of a set of forms and a valid identifier for each of the forms. Id., p. 4, ll. 17-23. The host computer is configured to receive an identifier in response to a request to audit a form. Id., p. 4, ll. 18-23; p. 5, ll. 9-12. The host computer verifies whether the identifier is a valid identifier for the audited form by comparing the identifier with the identifiers in the database. Id., p. 4, ll. 22-23. A record is produced in the database of the comparison. Id., p. 5, ll. 14-16.

Claim 16 recites an alternative forms auditing system that includes a host computer 12 associated with a database 14. Id., p. 3, ll. 21-25; Fig. 1, ref. nums. 12, 14. The database has a record of a set of forms and a valid identifier for each of the forms. Id., p. 4, ll. 17-23. A form identifier is associated with a form. Id., p. 4, ll. 17-23. The host computer is configured to receive an identifier in response to a request to audit a form. Id., p. 4, ll. 18-23; p. 5, ll. 9-12. The host computer verifies whether the identifier is a valid identifier for the audited form by comparing the identifier with valid identifiers in the database. Id., p. 4, ll. 22-23. A record is produced in the database of the comparison. Id., p. 5, ll. 14-16.

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Ground of Rejection I: Whether under 35 U.S.C. §102(e) claims 1, 6, 11, and 16 are anticipated under 35 U.S.C §102(e) by U.S. Patent No. 6,289,347 to Giroux ("Giroux"). Pages 2-3 of the Final Office Action describe the Examiner's current position on this issue.

Ground of Rejection II: Whether under 35 U.S.C. §103(a) claims 2-3, 5 and 15 are unpatentable over Giroux in view of U.S. Pub. No. 2006/0012473 to Bishop et al. ("Bishop"). Pages 4-5 of the Final Office Action describe the Examiner's current position on this issue.

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Ground of Rejection III: Whether under 35 U.S.C. §103(a) claims 4, 7-10, and 12-14 are unpatentable over Giroux in view of U.S. Pat. No. 5,799,285 to Klingman et al. ("Klingman"). Pages 5-9 of the Final Office Action describe the Examiner's current position on this issue.

7. ARGUMENT

Ground of Rejection I:

35 U.S.C. §102(b) rejection of claims 1, 6, 11 and 16

The Office Action rejected independent claims 1, 11 and 16 under 35 U.S.C. §102(e) as anticipated by Giroux. For a valid anticipation rejection, the Office must show that each limitation from the claims appears in a single piece of prior art. Appellants believe significant limitations from independent claims 1, 11, and 16 are neither taught nor suggested in the references. More specifically, the references cannot be relied upon to teach or suggest 1) "receiving an identifier in response to a request to audit a form" or 2) "verifying whether the form identifier is a valid form identifier for the form to be audited," as recited in claim 16. Similar limitations are also found in both independent claims 1 and 11.

The Final Office Action relies on Giroux to teach these limitations. Final Office Action, p. 3, ll. 18-22, citing Giroux, col. 3, ll. 30-36; col. 6, ll. 10-31. However, the Giroux reference instead describes a system for caching HTML forms for more efficient delivery. Giroux, Abstract, ll. 16-17; col. 4, ll. 51-52. The "system ... [acts] as a forms repository for user systems. Intermediate systems maintain libraries of HTML forms. Database requests are made by a user utilizing a standard Web browser. A database query is transmitted to a server system where it is processed. The response to the query is transmitted back to the intermediate system. The intermediate system will then check to see if it currently has the appropriate form matching the query response. If not, the form is requested from the server system." Id., col. 3, ll. 30-38.

The Giroux system, therefore, essentially describes a method of caching HTML forms at an intermediate system (i.e., the intermediate system and its local forms database; Giroux, col. 4, l. 62 - col. 5, l. 6; col. 6, ll. 19-23; Fig. 1, Ref. Num. 74). A particular "form and version number" are requested, and the intermediate system checks to see if there is a locally

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cached version of the form. Id., col. 6, ll. 19-28. If not, it retrieves the form by requesting it from the server 60. The reference states that this "... 'efficient' mode of operation significantly reduces the amount of bandwidth required to transmit data across the Internet, and ... allows for significantly greater throughput." Id., col. 4, ll. 59-64. Thus, the intermediate caching system of Giroux tries to *locate* an identified form locally so as to allow more efficient delivery.

The Giroux system is not accurately characterized in the Advisory Action dated February 5, 2007 ("Advisory Action"). The Advisory Action states that in Giroux, "the server determines or verifies if the form the user is requesting is the correct version of the form being requested." Advisory Action, p. 2. But this is not what occurs in Giroux. Instead, the intermediate system checks to see if it has the version number stored locally, and if not it retrieves it from the server system. Clearly, checking to see whether a form is *stored locally* for retrieval purposes is different than determining that a particular version number (e.g., a form identifier) is a *valid* identifier for the particular form.

This HTML form caching system described above clearly differs from the forms auditing system of the claims. The audit of the claims determines whether there is a *valid* form identifier. An attempt to *locate* a cached version of a form clearly differs from the determination of whether a particular version of a form is *valid*. The determination of whether a form is *present* at a location differs from a determination of *validity*. The request to audit the validity of a form, and the response thereto, are simply not present in Giroux. Giroux therefore fails to teach, "receiving an identifier *in response to a request to audit a form*," as recited in claim 16.

Moreover, claim 16 further recites "verifying whether the form identifier is a valid form identifier for the form to be audited." A similar limitation is found in claims 1 and 11. As noted above, Giroux fails to teach or suggest the determination of whether a form or its identifier is valid. Instead, the intermediate system simply attempts to locate a particular form cached in a local database to provide more efficient delivery. The claimed forms auditing is absent from Giroux - the lookup of a locally cached version of a form is different from verifying a valid form identifier in auditing a form.

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As the cited reference fails to teach or suggest all of the recitations of independent claims 1, 11, and 16, Appellants submit that these claims are allowable. Claim 6, which depends from these independent claims, is allowable for at least the same reasons. Therefore, Appellants respectfully request that the rejection under 35 U.S.C. §102(e) to claims 1, 6, 11, and 16 be reversed.

Ground of Rejection II:

35 U.S.C. §103(a) rejection of claims 2-3, 5 and 15

Claims 2, 3, 5 and 15 are rejected under 35 U.S.C. §103(a) as unpatentable over Giroux in view of Bishop. As a threshold matter, a *prima facie* rejection has not been properly set forth for these claims. Cites to Bishop are not proper, as this reference is not prior art. Bishop is a Patent Publication with a filing date of December 9, 2004. The present application was filed December 26, 2001.

In the Final Office Action, the Office notes that the issue was not specifically raised in the Response when the reference was initially cited. The Office appears to assert that this fact transforms Bishop into prior art. Appellants are not aware of legal precedent for such an assertion, and respectfully request that the Examiner cite such precedent. Appellants also note that grounds of rejection for which Bishop was initially raised were withdrawn.

To set forth a proper *prima facie* case, a cite to actual prior art is required. While Bishop is a CIP to a number of earlier patents, the only proper citation is to a parent with an earlier priority date, and in which a cited limitation is found. Appellants respectfully request that the rejections to claims 2, 3, 5 and 15 under 35 U.S.C. §103(a) be reversed on these grounds as well.

Claims 2, 3, and 5 depend from independent claim 1, which is allowable for the reasons given above. Claim 15 depends from independent claim 11, which is allowable for the reasons given above. Claims 2, 3, 5, and 15 are therefore also allowable for at least the reason that they depend from an allowable base claim. Therefore, Appellants respectfully request that the rejection under 35 U.S.C. §103(a) to claims 2, 3, 5 and 15 be reversed on these grounds, as well.

Ground of Rejection III:

35 U.S.C. §103(a) rejection of claims 4, 7-10, and 12-14

Claims 4, 7-10, and 12-14 are rejected under 35 U.S.C. §103(a) as unpatentable over Giroux and in view of Klingman. Claims 4 and 7-10 depend from independent claim 1, which is allowable for the reasons given above. Claims 12-14 depend from independent claim 11, which is allowable for the reasons given above. Claims 4, 7-10, and 12-14 are therefore also allowable for at least the reason that they each depend from an allowable base claim. Therefore, Appellants respectfully request that the rejection under 35 U.S.C. §103(a) to claims 4, 7-10, and 12-14 be reversed on these grounds.

8. CONCLUSION

For these reasons, it is respectfully submitted that the grounds of rejection should each be reversed.

Respectfully submitted,

Michael L. Drapkin
Reg. No. 55,127

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 650-326-2400
Fax: 650-326-2422
60982368 v1

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9. CLAIMS APPENDIX

1.   (Previously Presented) A method for auditing forms, the method comprising:

issuing a request to provide a form identifier that is associated with a form;

receiving the identifier at a host computer; and

verifying with the host computer whether the identifier is a valid identifier for the form being used.

2.   (Previously Presented) A method as in claim 1, wherein the request is issued from a terminal having a processor that is in communication with the host computer, and further comprising logging an error if the identifier is not valid.

3.   (Original) A method as in claim 2, wherein the request is sent from the host computer to the terminal.

4   (Original) A method as in claim 1, where the request is issued from a customer service operator over a phone.

5.   (Original) A method as in claim 2, wherein the identifier is received at the host computer from the terminal.

6.   (Original) A method as in claim 1, wherein the host computer includes an associated database, and wherein the identifier is verified by comparing the identifier with a list of valid identifiers in the database.

7.   (Original) A method as in claim 1, further comprising determining whether an appropriate form has already been ordered.

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8.   (Original) A method as in claim 7, wherein if an appropriate form has not been ordered, placing an order for an appropriate form.

9.   (Original) A method as in claim 8, further comprising evaluating whether the ordered form is received by a user.

10.   (Original) A method as in claim 9, further comprising transmitting an identifier for a replacement form to the host computer.

11.   (Original) A forms auditing system, comprising:

a host computer; and

a database associated with the host computer, the database having a record of a set of forms and a valid identifier for each of the forms;

wherein the host computer is configured to receive an identifier in response to a request to audit a form, and to verify whether the identifier is a valid identifier for the audited form by comparing the identifier with the identifiers in the database, and to produce a record in the database of the comparison.

12.   (Original) A system as in claim 11, further comprising a terminal having a processor, wherein the terminal is configured to receive the identifier of the form being audited and to electronically send the identifier to the host computer.

13.   (Original) A system as in claim 12, wherein the terminal is configured to produce an audit screen having a region for inputting the identifier.

14.   (Original) A system as in claim 13, wherein the terminal is configured to produce the audit screen based on information sent to the terminal from the host computer.

15.   (Original) A system as in claim 11, wherein the host computer is configured to generate in error report if the identifier of the form being audited is not valid.

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16.   (Previously Presented) A forms auditing system, comprising:

a form identifier that is associated with a form;

a host computer; and

a database associated with the host computer, the database having a record of a set of forms and a valid form identifier for each of the forms;

wherein the host computer is configured to receive the form identifier in response to a request to audit a form, and to verify whether the form identifier is a valid form identifier for the form to be audited by comparing the form identifier with the valid form identifiers in the database, and to produce a record in the database of the comparison.

10. EVIDENCE APPENDIX

None.

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11. RELATED PROCEEDINGS APPENDIX

None.